

### REMARKS

The Office Action mailed October 9, 2008 has been received and reviewed. Claims 1-14 and 17-62 are in the case. Claims 1, 22, and 39-41 stand rejected under 35 U.S.C. § 102(b). Claims 2-14 and 17-62 stand rejected under 35 U.S.C. § 103(a).

Applicant submits herewith a Declaration of Michael M. Evans Under Rule 132 pointing out facts supporting non-obviousness by reason of 1) unusual commercial success, 2) satisfying a long-felt need that was recognized, persistent, and not solved by others, and 3) traversal of the numerous assertions of inherency and obviousness posited in the Office Action. In view of that declaration with its attached, full-color exhibits, and for the reasons set forth below, claims 1-14 and 17-62 are believed to be in condition for immediate allowance. Favorable reconsideration of the application in view of the following remarks is, therefore, respectfully requested.

#### **Rejection of Claims 1, 22, and 39-41 Under 35 U.S.C. §102(b)**

Claims 1, 22, and 39-41 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shills. However, a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See* MPEP §2131. Applicant does not find each and every claim element in Shills. Accordingly, Applicant asserts that the anticipation rejection based on Shills should be withdrawn.

For example, Applicant’s claims require a distribution of globules or medallions that varies substantially randomly in lateral width along the longitudinal direction. Applicant does not find in Shills any disclosure of a structure or step configured to create such a distribution. Rather, Applicant finds Shills to teach against such a structure. For example, the widths of Shills’ spray patterns 96, 98, 102 are, and must be, substantially constant. Applicant further finds

that the those widths are determined by the widths of Shills' corresponding scrapers 66, which cannot be random.

For example, Shills discloses that the "base coat applicator 50 has a configuration like that of the first overspray applicator 52 ... with the exception that the scraper 66 thereof is wide enough to extend across the entire lengths of the drum 62 and the brush 64." *See* Shills at col. 7, lns. 35-39. Accordingly, the spray pattern 96 of the base coat applicator 50 "extends across the entire width of each of the passing tiles" thereby coating "essentially the entire top surface 74 of each passing tile 10." *See* Shills at col. 7, lns. 41-46. In contrast, "the overspray applicator 52 has a scraper 66 the length of which is substantially less than the lengths of the drum 62 and brush 64" to create a spray pattern 98 that has "a width less than that of the tiles 10." *See* Shills at col. 7, lns. 50-56.

While the lateral location of Shills' spray patterns 96, 98, 102 may vary (oscillate), the widths of those spray patterns 96, 98, 102 is not random. Whether a spray of paint from a rotating brush of Shills (or a spray paint gun or can of spray paint) includes individual droplets that might be considered random individually, the resulting distribution is still directed regularly and has a very predictable, statistical distribution. This is the antithesis of a distribution having a random width. As seen, for example, in Exhibit B of the declaration, swaths of color produced by the Shills device are statistical distributions that do not have a random width as required by the claims of Applicant.

Thus, Applicant asserts that Shills fails to disclose, and indeed teaches against, Applicant's distribution that varies substantially randomly in lateral width along the longitudinal direction. Shills cannot, therefore, anticipate Applicant's claims.

Applicant does not find in Shills a teaching or suggestion of applying medallions as that term is described by Applicant. A comparison of the “Vintage” tiles of Applicant illustrated in Exhibit A with the Shills products in Exhibits B, C and D of the attached declaration, in view of paragraph 12 of that declaration, seems to militate against the arguments maintained by the examiner that Shills teaches any form of accent that could be considered a medallion as that term is defined by Applicant’s specification and as used in Applicant’s claim.

In view of the foregoing, Applicant asserts that Shills fails to anticipate, and indeed teaches against, Applicant’s claims as recited. Reconsideration is respectfully requested.

**Rejection of Claims 1, 22, and 39-41 Under 35 U.S.C. §103(a)**

Claims 1, 22, and 39-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills. However, to establish a *prima facie* case of obviousness, the Office action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. Applicant asserts that the Office Action fails to meet this test.

Shills does not teach or suggest all of the limitations of Applicant’s claims. As set forth hereinabove, Applicant does not find in Shills any teaching or suggestion of a distribution of globules or medallions that varies substantially randomly in lateral width along the longitudinal direction. Applicant asserts that the applicators 50, 52, 54 of Shills teach against Applicant’s claimed invention. The apparatus and method of Shills would have to be destroyed in structure and function, and then completely re-engineered to new structures and functions before they would be able to deliver distributions with random widths. Such re-engineering would certainly change the principle of operation of Shills and cannot therefore be an obvious modification. *See*

MPEP §2143.01(VI). Furthermore, the Office Action is silent on this issue. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

As a side issue with respect to all rejections of claim containing a recitation of “medallions” on the basis of obviousness in the Office Action, Applicant does not find in Shills a teaching or suggestion of applying medallions as that term is described by Applicant and recited in the claims. A comparison of the “Vintage” tiles of Applicant illustrated in Exhibit A with the Shills products in Exhibits B, C and D of the attached declaration, in view of paragraph 12 of that declaration, seems to militate against the arguments maintained by the examiner that Shills teaches any form of accent that could be considered a medallion as that term is defined by Applicant’s specification and as used in Applicant’s claim.

In view of the foregoing, Applicant asserts that the Office Action does not provide references having all the elements recited, nor a clear articulation of why the claimed would have been obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

**Rejection of Claims 2 and 44-53 Under 35 U.S.C. §103(a)**

Claims 2 and 44-53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Maurer. However, to establish a *prima facie* case of obviousness, the Office action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action fails to meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant’s claims. Adding the teachings of Maurer to those of Shills does not remedy the

deficiencies noted above. Accordingly, the Office Action does not find all the required elements recited and provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, the Office Action asserts that Maurer teaches a synthetic roofing member capable of brushing to provide texturing. However, this is not accurate. Applicant finds that Maurer teaches brushing such as that done on natural slate to highlight the patterns on the already formed (and hardened) members 10. *See* Maurer at col. 3, ln. 66 through col. 4, ln. 3. Thus, the brushing taught by Maurer is smoothing in order to be more conspicuously reflective of light, thus “highlighting” not texturing.

The Office Action argument elevates form over substance, quibbling with the presence of a particular word at the expense of ignoring the actual teaching. The Office Action errs in so doing. The reference’s use of a brush teaches the opposite of texturing as described by Applicant and recited in the claims. Accordingly, the Office Action has not provided the required clear articulation of why the claimed invention would have been obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

**Rejection of Claims 5-14, 17-21, 23-29, 31-43, and 54-60 Under 35 U.S.C. §103(a)**

Claims 5-14, 17-21, 23-29, 31-43, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of De Paoli. However, to establish a *prima facie* case of obviousness, the Office Action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's claims. Adding the teachings of De Paoli to those of Shills does not remedy the deficiencies noted. Accordingly, the Office Action does not find the required elements and a provide clear articulation of why the claimed invention would have been obvious.

Additionally, the Office Action states that it would have been obvious to incorporate the method of De Paoli into that of Shills. Applicant respectfully asserts that this statement is improper. The method of De Paoli is incompatible with that of Shills. De Paoli teaches a method wherein a slab of terrazzo with stone chips up to two inches in size is poured, then preformed spatters are inserted by hand. The result is then cured and ground smooth. *See De Paoli* at col. 1, lns. 30-36 and col. 1, ln. 62 through col. 2, ln. 29. This process bears no resemblance to the method of Shills.

Moreover, the applicators 50, 52, 54 of Shills would have to be replaced with a structure re-engineered to a different purpose to ever insert spatters as taught by De Paoli. Thus, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious. Moreover, the proposed modification or combination of the prior art would impermissibly change the principle of operation of Shills. *See MPEP* §2143.01(VI).

Also, the Office Action asserts that De Paoli teaches medallions that would inherently simulate the appearance of biota. However, Applicant finds that De Paoli teaches terrazzo that is "ground smooth" with a "fine finished condition." *See De Paoli* at col. 2, ln. 17 and col. 3, lns. 7-10. Applicant finds nothing in such a surface, that has ground stones and binders smooth and exposed to form a fine finish, to ever simulate the appearance of biota. Again, the Office Action does not find the recited elements nor provide the required clear articulation of why the claimed

invention would have been obvious. In view of the foregoing, reconsideration is respectfully requested.

**Rejection of Claims 3, 4, and 30 Under 35 U.S.C. §103(a)**

Claims 3, 4, and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Arpin. However, to establish a *prima facie* case of obviousness, the Office action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's claims. Adding the teachings of De Paoli to those of Shills does not remedy the deficiencies noted. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, it is improper to combine references where the references teach away from their combination. *See* MPEP §2145(X)(D)(2). In this case, Shills expressly teaches the use of a "slurry." A slurry is "a watery mixture of insoluble matter." *See* [www.merriam-webster.com](http://www.merriam-webster.com) (emphasis added). Thus, it is improper for the Office Action to force the use of "the driest consistency possible," as assertedly taught by Arpin, on Shills.

In view of the foregoing, reconsideration is respectfully requested.

**Rejection of Claim 53 Under 35 U.S.C. §103(a)**

Claim 53 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Maurer and Maletic. However, to establish a *prima facie* case of obviousness, the Office

action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action does not meet this test.

As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's claims. Adding the teachings of Maurer and Maletic does not remedy the deficiencies noted. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

Additionally, Applicant does not find in the combination of Shills, Maurer, and Maletic any teaching or suggestion of texturing the top surface of a substrate in a pattern with a random orientation. In contrast, Applicant finds that Maletic teaches a very regular texturing pattern with a regular orientation. The Office Action is silent on this issue and provides no citation to any teaching of a random orientation. Accordingly, the Office Action does not provide the required clear articulation of why the claimed invention would have been obvious.

In view of the foregoing, reconsideration is respectfully requested.

**Rejection of Claims 12, 17-20, and 54-60 Under 35 U.S.C. §103(a)**

Claims 12, 17-20, and 54-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Gundlach and Chaffee. However, to establish a *prima facie* case of obviousness, the Office action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action does not meet this test.



As set forth hereinabove, Shills does not teach or suggest all of the limitations of Applicant's claims. Adding the teachings of Gundlach and Chaffee does not remedy the deficiencies noted. Reconsideration is respectfully requested.

**Rejection of Claim 61 Under 35 U.S.C. §103(a)**

Claim 61 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Chaffee in view of Shills. However, to establish a *prima facie* case of obviousness, the Office action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action does not meet this test.

As acknowledged by the Office Action, Chaffee does not teach applying a random distribution. Shills fails to cure this missing element, as set forth hereinabove. Moreover, Shills' system would have to be effectively destroyed and completely re-engineered to a new purpose before Shills' applicator 50, 52, 54 could limit the various coats to an exposed portion of a tile. Moreover, the abrupt change required by the boundary line of the coating of Chaffee cannot be met by Shills, which teaches a gradual starting and stopping of the feed and the flipping of the slurry with respect to the rotating brush. Thus the references cannot properly be combined, since they teach against one another and applying the teachings of Shills to the invention of Chaffee would destroy the ability of the Chaffee invention to accomplish its purpose. Moreover, their combination would not result in the invention.

In view of the foregoing, Applicant asserts that the Office Action does not find all the required elements and provide a clear articulation of why the claimed would have been obvious.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections.

**Rejection of Claim 62 Under 35 U.S.C. §103(a)**

Claim 62 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Shills in view of Chaffee and Pollock. However, to establish a *prima facie* case of obviousness, the Office action must find in the prior art all the elements recited in the claim and provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The Office Action fails to meet this test.

As described hereinabove with respect to claim 61, a combination of Shills and Chaffee does not render Applicant's claimed invention of claim 62 obvious. Likewise, the arguments hereinbelow apply to claim 61. Shills teaches against the abrupt line of demarcation taught by Chaffee.

Moreover, Applicant does not find in Shills or any other reference a teaching or suggestion of means for creating the boundary of Chaffee's coating, nor the medallions of applicant on substantially exclusively the exposed portion of a tile.

Also, A comparison of the "Vintage" tiles of Applicant illustrated in Exhibit A with the Shills products in Exhibits B, C, and D of the attached declaration, in view of paragraph 12 of that declaration, seems to militate against the arguments maintained by the Office Action that Shills teaches any form of accent that could be considered a medallion as that term is defined by Applicant's specification and as used in Applicant's claim.

Likewise, applicant does not find in the combination of Shills and Chaffee the random width of distribution, as discussed hereinabove with respect to claim 1.

Moreover, Applicant fails to find in Chaffee any suggestion of colors corresponding to biota, which colors are discussed in detail by Applicant. Such coloration and accents are the opposite of the “grit surfacing applied to asphalt roofing” and used by Chaffee in 1929 for his “shingle slab” having “the appearance of individually laid shingles,” meaning asphalt composition shingles. *See, e.g.*, Chaffee Column 1, lines 28-53. Such teachings against Shills and Applicant are evidence of non-obviousness. Also, with respect to these elements, Chaffee, Shills, and Pollock together do not provide all the required elements recited in Applicant’s claim.

The combination of Pollock is improper, and does not cure the deficiencies of the other references used in combination therewith. Pollock teaches directing by an artist the position of paints and colors by the artist as he may “walk around it, work from all four sides, and be in the painting.” *See e.g.*, USPN page 4, Paragraph 5. Also, the Office Action cites to flinging by hand, when such a teaching is opposite the required automated structures and methods central to Shills’ invention and is, therefore, not proper to combine with the teachings of Shills. It would destroy the purpose of Shills to apply flinging of Pollock, rendering it unsatisfactory for its intended purpose.

Also, Applicant asserts that Shills’ even and uniform base coats generated by the same apparatus in a continuous flipping of droplets by the mechanisms of Shills could not be duplicated by hand throwing. The Office Action remains still silent on this issue, raised before by Applicant. Accordingly, the Office Action does find the required elements recited and does not provide the required clear articulation of why the claimed invention would have been obvious.

### **Secondary Considerations Under 37 CFR §1.132**

Applicant has provided the attached Declaration of Michael M. Evans Under Rule 132 and its associated Exhibits A-D supporting non-obviousness of the invention and negating certain assertions of the Office Action.

For example, the Office Action dismisses many elements recited in Applicant's claims as being "inherent" in a reference with little or no support cited. With respect to those assertions, Applicant responds with paragraphs 1-4 and 12 specifically, and with the entire declaration generally, in addition to the arguments hereinabove. Particularly, the Exhibits A-D demonstrate that "inherent" does not properly apply. A Webster's unabridged dictionary may be readily accessed in hard copy or in software to define inherent as "existing in someone or something as a permanent and inseparable element, quality, or attribute."

For example, one may compare the invention of Applicant exemplified in Exhibit A with the invention of Shills, as exemplified in Exhibits B-D. Even if Shills were capable of combining with the other references relied upon in the Office Action, inherency is not supported. Many of the features mentioned as "inherent" in the Office Action are not a "permanent and inseparable element, quality, or attribute" of the methods and apparatus taught in the cited art.

Moreover, paragraphs 4-7 and 10-11 demonstrate an uncharacteristically enthusiastic commercial success and some of the responses and reasons therefor by customers and prospective customers. The unusual commercial success is shown to be due to the features of the recited method and the novel product features resulting from the claimed methods, rather than other stimuli such as increased marketing effort, market shifts, and the like.

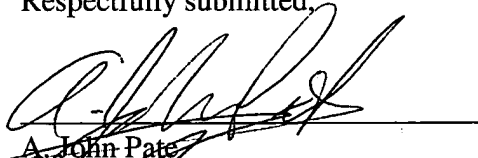
Paragraph 5-11, and 15, and particularly paragraphs 11 and 15 demonstrate a long-felt and unsatisfied need that has persisted and remained unmet by the alternative, recycled, naturally aged tiles from old buildings.

In view of the foregoing, Applicant asserts that the Office Action does not find all elements of Applicant's recited claims and provide a clear articulation of why the claimed would have been obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the claim rejections. In view of the foregoing, reconsideration is respectfully requested.

In the event that the examiner finds any remaining impediment to the prompt allowance of any of these claims, which could be clarified in a telephone conference, the examiner is respectfully urged to initiate the same with the undersigned.

DATED this 9th day of December, 2008.

Respectfully submitted,

  
A. John Pate  
Reg. No. 36,234  
Attorney for Applicant

Date: December 9, 2008

PATE PIERCE & BAIRD  
175 South Main Street, Suite 1250  
Salt Lake City, Utah 84111  
Telephone: (801) 530-0330  
Facsimile: (801) 530-5955